

REMARKS

Reconsideration and allowance of this application are respectfully requested in light of the following remarks.

I. Office Interview

Applicants thank the Examiner for the interview on September 10, 2003, after a Final Rejection was issued. Based on the Final Rejection's allegations that the cited prior art taught a replicated, distributed, database, issues were discussed at the interview and that discussion is summarized as follows:

1. Examiner alleged that the cited ILOG JRules press release reference taught access to rules by more than one manager and therefore implied that the rules were network-accessible and did not require an explicit teaching to be cited as a reference for a networked database.
2. Examiner alleged that an explicit teaching of a database was not required in any reference cited because "Where else would you store it?" when discussing storage of roles, rules, and ads in a database as recited by the invention of Claims 1 and 20.
3. The Examiner repeatedly alleged that the present invention is a workflow application and that ILOG JRules implemented workflow.

All three of these allegations lead Applicants to the conclusion that the Examiner is reading teachings into the prior art that are not only not taught but are not even intended by the authors of the prior art and as such are contrary to US patent law.

The ILOG JRules reference does not teach storing business rules in a database but does teach rules are separate from the application code and that ILOG JRules itself can be embedded in Enterprise Java Beans (EBBS) (page 3, line 16). Elsewhere, the

cited ILOG JRules reference teaches that standard XL tools can be used to generate executable rules (page 3, line 2). These are not a teaching of a database. Further, none of the other cited references teaches a database of any kind. Applicants respectfully point out that a database is a term of art that refers to a specific type of data storage that is accessible via a user interface comprising a query language. A database may implement a standard data model or a proprietary data model but a data model is understood and required as a fundamental feature of a database by those ordinarily skilled in the art. No such database is even implied in any cited reference. Further, one ordinarily skilled in the art would perceive that the storage of data associated with each of these references would more likely be in a commonly known file structure or a proprietary file structure and not in database. In fact, the Kashino reference teaches using a common PDF file structure since Kashino is an invention concerned with editing images. Thus, in response to the Examiner's query "Where else would you store it?" Applicants' answer is in a file and not in a database since there is no teaching in any reference of any mapping of data to a data model, as required for use of a database.

As discussed above, the ILOG JRules reference teaches that the rules are kept separate from the application code (page 2, line 20), where before they had been "buried in software systems using traditional programming techniques," (page 2, line 16) and that they are processed by a rules engine that uses sophisticated algorithms that optimize the use of computing resources for rule processing (page 2, line 18). This teaching would, Applicants assert, lead one ordinarily skilled in the art to the conclusion that ILOG JRules stores business rules in a proprietary file format which is interpreted by ILOG JRules proprietary rules engine.

In order to supply the missing elements of the references,

the Examiner must allege that they are either expressly taught in language other than used in the claims or that the claimed limitation is nonetheless inherent in the reference. The Examiner has made no such allegation and there is no such other language in the cited references for networks, databases and workflow. If the Examiner is alleging that the expression is inherent, a network, a database, and a workflow must be the one and only alternative possible and clearly this is not the case. More than once manager can access a central computer from attached terminals, a network is not required. A database is not the only storage alternative, since, as discussed above, a file structure is a more likely storage than a database and as such represents an alternative to a database.

Concerning the allegation that the present invention teaches workflow, there is no description of the present invention as a workflow application. Other than the natural sequencing that occurs because one step follows another and requires a prior step to have been completed, the present invention is not a workflow application as that term is used by one ordinarily skilled in the art. Finally, none of the instant claims recite workflow related limitations.

With respect to a network, none of the cited references teaches a network even in language different from that used in the present application. Kashino teaches a communication line, which could be a dial-up telephone line, that is used to send a PDF file. A network is not the only alternative. None of the other references explicitly teaches a network.

Therefore, since the primary Kashino reference lacks any such teaching of a database and a network and expressly teaches away from a database by teaching a PDF file as a storage structure, and the ILOG JRules reference having the above discussed deficiencies, it cannot be said that the combination of these references alone or with other references establishes a

prima facie case of obviousness.

II. Withdrawal of Rejection of Claim 12 as Indefinite Under 35 U.S.C. §112

The rejection of Claim 12 as indefinite Under 35 U.S.C. §112, 12 has been withdrawn stating that

"...the claims will be interpreted as claiming accessing of the Ad box default templates or A Master Template and Ad Box instances, in the database, by plurality of roles associated with the Ad Box default template or Ad Master template to perform one of creating, ..."

However, Applicants respectfully point out that, in the claimed invention, **both**

1. accessing of the Ad box default templates in the database

and

2. accessing of A Master Template and Ad Box instances, in the database

are being recited. It is **not** 1. **or** 2., that is, there is no alternative claiming language recited in claim 12.

III. ILOG JRules Reference Is Not Enabling

It is well settled that prior art references must sufficiently describe the claimed invention to have placed the public in possession of it, see, e.g., *Elan Pharmaceuticals, Inc. and Athena Neurosciences, Inc., v. Mayor Foundation for medical Education and Research*, 2003 U.S. App. LEXIS 20195 (Oct. 3, 2003). Such possession is effected if one of ordinary skill in the art could have combined the publications' descriptions of the invention with his own knowledge to make the claimed invention.

That is, there is no description of the format of any ILOG JRule business rule or the business rule definition language or how one skilled in the art would use the language to define,

generate, and incorporate such a defined ILOG JRule business rule into an application. There is only the statement that it would be easy to extend and customize provided sample business rule languages (which are also not taught by the cited reference) to a specific application or industry. This is not an enabling teaching. It is not even a teaching but press release hyperbole, as previously stated by Applicants. Therefore, contrary to the allegation of the Final Rejection on page 3 first paragraph, this prior art reference does not teach means or manner for specifying companies business rules because it discloses nothing about means or manner for specifying business rules except that it will be easy to extend and customize provided sample business rule languages (note not the rules themselves) when they are finally released.

Accordingly, even if the claimed invention is disclosed in a combination of printed publications, that disclosure alone will not suffice as prior art if it is also not enabling. Applicants reassert that nowhere in the cited ILOG JRules reference is any of the statements, particularly pointed out in the prior Office Action and current Final Rejection, enabled by a teaching sufficient to place the invention in the possession of one ordinarily skilled in the art without undue experimentation.

Applicants' prior argument filed on May 08, 2003, that the press release cited as prior art is not an enabling teaching has not been properly addressed by the Final Rejection. In response to Applicants' argument, the Final Rejection again cites a prior art reference for its unsupported statement that the ILOG JRules product (at that time not available because not yet released) simplifies business rule definition and implementation and provides sample business rule languages customizable to a specific application or industry. Again, Applicants respond that these unsupported statements, recited in the cited ILOG JRules press release, are not an enabling teaching but represent a

marketing device containing exaggerated, i.e., puffing-type statements concerning capabilities of a then (at the time of the press release) as yet to be released product.

Furthermore, an enablement determination is made retrospectively, i.e., by looking back to the filing date of the patent application and determining whether undue experimentation would have been required to make and use the claimed invention at that time. Applicants assert that business rule technology was (and still is) relatively new and little known to persons skilled in the art of advertisement application development at the time of the invention. Without a teaching of any kind in the ILOG JRules press release as to format, etc., someone ordinarily skilled in the art of advertisement application development would have had to perform undue experimentation given only the cited prior art (which includes ILOG JRules press release) in order to combine the cited prior art references to achieve the invention of claims 1-26. This is directly due to the lack of any teaching of the format of the business rules produced by ILOG JRules or the definition language or any other enabling description concerning business rules in the cited press release.

IV. Definition of Business Rules

In their reply to the prior Office Action filed on May 08, 2003, Applicants refer to the definition of a business rule, provided in the ILOG JRules reference cited by the Examiner in the Office Action, as "statements of business policies and procedures that drive day-to-day business activity" (ILOG, page 2, line 15) as the definition being used by the Examiner. However, the Final Rejection alleges that the Examiner does not understand what definition was used in the Office Action for a business rule. Either the business rules provided by ILOG JRules are defined as "statements of business policies and procedures that drive day-to-day business activity" (ILOG, page 2, line 15)

or they are not. The Examiner cannot have it both ways because Applicants are being denied due process in knowing the reason the Examiner is rejecting the claims. If the Examiner is adopting a different definition than the one provided by the reference, then the Examiner should make explicit the definition being used. The Office Action and the Final Rejection lack such a definition by the Examiner and the Examiner having cited a reference that provides a definition of business rules as "statements of business policies and procedures that drive day-to-day business activity" (ILOG, page 2, line 15), Applicants have justifiably concluded that this is the definition of a business rule that the Examiner has adopted and is using in the arguments made by the Examiner in the prior Office Action and reiterated in their entirety in the current Final Rejection.

Given this definition, the Examiner's allegation that Kashino teaches preparation and administration of ads for publication by said roles *according to business rules* is not supported because Kashino only teaches a demand, which is not a business rule but is a customer's requirements that are translated by an advertisement agency for giving as instruction to a publisher so as to prepare contents of advertisement to comply with the demand (see Fig.7 and related columns). That is, the demand determines what is in the ad and is not "statements of business policies and procedures that drive day-to-day business activity" (ILOG, page 2, line 15). Nowhere in the cited reference does Kashino teach business rules according to the definition adopted by the Office Action.

- V. Claims 1-4, 20, 25 and 26 are rejected under 35 U.S.C. §103(a) as being unpatentable over Kashino (U.S. Patent No. 6,166,716, in view of ILOG JRules Software as taught by Article "New ILOG JRULES Software is First to Bring Business Rule Creation to Business People" PR Newswire; New York; Apr 5, 2000, (Hereinafter "ILOG").

The Office Action Position

The Office Action alleges that Kashino teaches company advertiser and ad publisher personnel roles to accomplish preparation of ads for publication (col. 8 line 48 to col. 9 line 28) and preparation and administration of ads for publication by said roles according to business rules (see FIG. 7 and related columns). The Office Action admits that Kashino does not teach specifying business rules to control preparation and administration of ads for publication and storing the rules and personnel roles in a database. The Office Action alleges that ILOG teaches specifying customized business rules for specific applications or industry. The Office Action further alleges that ILOG teaches specifying business rule definition and implementation as well as workflow management, logistics and exchanges (page 1-3 of ILOG press release) The Office Action also alleges that both Kashino and ILOG teach networked, distributed and replicated database (citing Kashino col. 8 line 48 to col. 9 line 28 and ILOG page 3).

Applicants Response

At the outset Applicants again assert that the hyperbole of a press release is not a teaching, but a marketing device containing exaggerated, i.e., puffing-type statements concerning capabilities of a then (at the time of the press release) as yet to be released product (see pricing and availability on page 3). That this is the case is supported by (1) "Forward-Looking Information" et seq, at the bottom of page 3 and continuing on the top of page 4 of the press release as well as (2) Applicants observation that a business organization relying on a business rules application is going to have that application under strict configuration control. Strict configuration control, as practiced by anyone ordinarily skilled in the art means that changes are not made to an operational system (e.g., a business rules system)

by those not ordinarily skilled in the art, as suggested by the ILOG JRules press release. Typically, all changes are submitted to a maintenance organization that maintains the business rules application, are evaluated and approved/disapproved, implemented if approved and TESTED to insure the changes work and are compatible with existing business practices. This change implementation is never done by business analysts and end users because it would result in a non-working business rules system. So that the claim in the "New ILOG JRules Software" press release that their new capabilities bring this technology beyond just highly skilled developers to a wider community of business analysts and end users is just hype. No organization with an investment in a business rules application is going to risk their system's integrity and operation by allowing such a wider community (of individuals not ordinarily skilled in the art) to change it.

With regard to roles, at the point in the reference cited by the Office Action (col. 8 line 48 to col. 9 line 28), (1) Kashino does not teach specifying company advertiser and ad publisher personnel roles to accomplish preparation and administration of ads for publication; and (2) Kashino does not teach any advertiser roles, both as recited by present independent Claims 1 and 20, but merely states that correcting work is done by an advertiser who participate (sic) in this publishing work (col. 9 lines 21-24). At most, Kashino teaches ad creation (editor) and correction roles (designer and copy writer) for publisher personnel (col. 9 lines 25-28) but does not teach means for specifying roles and does not teach storing roles in a database.

With regard to business rules, the Office Action has provided a reference that defines business rules as "statements of business policies and procedures that drive day-to-day business activity" (ILOG, page 2, line 15). Kashino teaches at FIG. 7 and related columns, an ad preparation system comprising

an advertiser who places an order for an ad with an advertisement agency that gives an *instruction* to a publishing company so as to prepare *contents of advertisement* in comply with the need of the advertiser, a publisher editor in charge prepares advertisement pages in accordance with the advertiser's demand with being helped by an external designer or copy writer, and the ad is finally sent to a *printing company* for printing. The advertiser's demand is not a business rule, according to the definition provided by the Office Action. It is a one-off requirement for a particular ad, in this case for a mail order ad in a magazine. Contrary to the allegation of the Office Action, nowhere does Kashino teach means for specifying or specifying company advertiser and ad publisher rules and personnel roles for preparation and administration of ads by company advertiser and publisher personnel roles according to specified business rules, as recited by independent Claims 1 and 20, respectively.

The Office Action admits that Kashino does not explicitly teach specifying the business rule of preparation and administration and personnel roles to accomplish the preparation and administration of the advertisement and storing the rules and roles in a database. The Office Action alleges that this is taught in the cited ILOG JRules Press release. Applicants respectfully disagree. The cited reference, ILOG JRules, nowhere even mentions personnel roles much less represents a teaching of personnel roles. Further, ILOG JRules does not teach storing rules in a database as recited by Claims 1 and 20.

ILOG does not remedy any of these deficiencies of Kashino. Nowhere does the ILOG JRules press release even mention roles or specifying roles for preparing a product and administering the product preparation process. There has to be some motivation to combine references and there is none here. While the ILOG JRules product allegedly provides a business rules engine and a business rule definition language that is customizable to a given

industry, Kashino cannot be modified to employ such business rule definition language and business rules engine because Kashino does not anywhere teach employing business rules.

Regarding the allegation of the Office Action that ILOG teaches specifying business rule definition and implementation as well as workflow management, logistics and exchanges (pages 1-3), Applicants respectfully point out the ILOG press release only states "Sophisticated new features in ILOG JRules simplify business rule definition and implementation for these applications [B2B e-business applications], as well as [for] workflow management, logistics and exchanges." The press release does not state what these features are, but it is discussed that ILOG JRules provides business rules support for workflow management, logistics and exchanges. In effect, the ILOG JRules reference sets forth only the desired result, such as turning lead into gold, but does not describe how to do it or enable one skilled in the art to use his experience to achieve the desired result without undue experimentation.

As regards the Office Action allegation that both Kashino and ILOG teach networked, distributed and replicated databases nowhere do either Kashino or ILOG even mention distributed, replicated databases let alone networked databases. At the cited reference, Kashino only teaches a PDF file that is distributed to respective correctors using a communication line (col. 9 lines 18-21) and ILOG only states on page 3 that

"JRules offers many features for developers that speed rule deployment and improve performance, including: ...

-- Automatic integration between the rule engine and relational databases, allowing users to define business rules that reference data stored in RDBMS (relational database management systems)."

The ILOG reference nowhere discusses networked, distributed, replicated databases, as alleged by the Office Action.

With regard to the Office Action's allegation that it would have been obvious to one of ordinary skill to combine Kashino's publishing of ads and ILOG's software (which is nowhere stated to have been available to the public) for creating business rules because one would have been motivated to implement ILOG's software to create business rules for Kashino's publishing of ads for the purpose of describing and controlling the structure, operation and strategy of the publication business. Applicants respectfully assert that since Kashino does nowhere teach the use of business rules for any purpose, let alone controlling the structure, operation and strategy of the publication business, it would not have been obvious how to modify Kashino to use ILOG's as yet unavailable software, especially since Kashino is directed to a presentation apparatus for cooperative correction by a plurality of correctors of two dimensional picture information and not to the structure, operation and strategy of the publication business.

Finally, Applicants assert that ILOG is a tool like a compiler or a relational database management system or a knowledge base combined with an inference engine. ILOG does not provide business rules off-the-shelf, these rules have to be defined for each business and project, see brochure for Business Rules Workshop attached hereto as Attachment #1. And, just like a tool such as a compiler or a relational database management system or a knowledge base combined with an inference engine, does not render obvious all the software and hardware inventions that use a compiler, a relational database management system, or a knowledge base combined with an inference engine, neither does ILOG render obvious all inventions that use a tool such as ILOG to define and implement business rules. The Business rules express the constraints associated with a business method/process and ILOG is just a tool for capturing business rules via a

special purpose and implementing the captured business rules. The existence of a tool and some examples of its input language does not render obvious inventions that incorporate the product of the tool.

In view of all of the foregoing discussions, the Office Action has not made out a prima facie case of obviousness, the rejections should be withdrawn, independent Claims 1 and 20 are allowable, and Claims 2-19 and 21-26, respectively dependent therefrom, are allowable for at least this reason.

VI. Claims 5-19 and 21-24 are rejected under 35 U.S.C. §103(a) as being unpatentable over Kashino, in view of ILOG and further in view of Johnson et al (U.S. Patent No. 6,453,301, hereinafter "Johnson").

The Office Action Position

The Office Action admits that Kashino, even presumably as modified by ILOG, not teach Ad Box default template defining a plurality of entries for each Ad Box instance or Ad Master template defining a plurality of components for each Ad Master instance; ... setting said status. The Office Action alleges that Johnson teaches a presentation generation system that integrates customer specific information with a selling entity element to generate a presentation item for sale of product customized for a particular customer of the selling entity (Abstract). The Office Action further alleges that Johnson teaches templates used to develop a presentation item (ad) such as programs, rules or instructions, where the templates include presentation format templates indicating the various information to be integrated to form a presentation item (ad). The presentation format template associate with rules defining for example, the layout of a presentation item which implies that templates [are] being controlled by associated business rules and [are] being defined by at least one of company advertiser and ad publisher. Johnson further alleges that it would have been

obvious to one of ordinary skill in the art to modify Kashino's publication of ads by include (sic) Johnson's templates associated with and controlled by business rules in order to quickly and easily create the presentation (ad).

Applicants Response

The customer solution system 102 taught by Johnson generates a customized presentation, not an advertisement, of available products of a selling entity to be presented to a customer that is based on the customer's requirements for those products (customer specific information) (Abstract; col. 3, lines 23-51). If a customer is seeking to buy advertising the customer solution system 102 product data may include advertisement medium, advertisement product features, advertisement length, broadcast time, broadcast coverage, etc. (col. 5, lines 53-56). FIG. 1BA-0 are examples of custom presentations for a sales proposal for selling advertising space in a newspaper, they are not the actual ads prepared for publication in at least one delivery medium as claimed by present claims 1-26.

The presentation system taught by Johnson supports a seller organization by generating custom presentations based on customer requirements for products sold by the sales organization. Johnson calls these presentations "proposals" because they are presented to the customers who requested them and are not published as advertisements (see, e.g., col. 2, line 2; FIG. 18A-0; FIG. 19A-P; FIG. 20A-N; col. 3, lines 29, 60, & 65; col. 4. lines 41; col. 6, lines 42 & 54).

Thus, Johnson does not cure the admitted deficiencies of Kashino that Kashino, as modified by ILOG, not teach Ad Box default template defining a plurality of entries for each Ad Box instance or Ad Master template defining a plurality of components for each Ad Master instance; ... setting said status. Johnson teaches capturing customer requirements and matching them to

available products, developing a customer solution based on the matching and then generating a presentation of the solution to the customer using a pre-stored template and pre-stored data for entities selected for inclusion in the solution (see, e.g., FIG. 3, especially elements 304-310). Johnson is not teaching means for preparation and administration of ads for publication as recited by claim 1 or preparing and administering ads for publication as recited by claim 20. In addition, as discussed above, Kashino has several other deficiencies which, as argued above, are not cured by ILOG JRules, i.e., the Office Action admits that Kashino does not explicitly teach specifying the business rule of preparation and administration and personnel roles to accomplish the preparation and administration of the advertisement and storing the rules and roles in a database. Johnson also does not cure these other deficiencies.

Therefore, the Office Action has failed to make out a *prima facie* case of obviousness, the rejections should be withdrawn, Claims 5-19 and 21-24 are allowable.

Conclusion

Applicants summarize their arguments as follows:

1. Cited prior art does not teach means for specifying roles as recited by Claims 1 and 20, Kashino does not teach any means for specifying roles.
2. Cited prior art does not teach storing specified rules, roles, and ads in a database as recited by Claims 1 and 20. Examiner has broadly cited ILOG as teaching such a database but ILOG JRules only teaches referencing application RDBMS and does not teach storing rules in a database along with roles and ads. That is, the Examiner has not cited any part of any cited reference as supporting such a teaching of a database storing rules, roles, and ads

3. Cited prior art does not teach a networked, replicated, distributed database and the Examiner has cited no part of any reference as supporting such a teaching. ILOG JRules page 3 does not teach a networked (Internet), distributed and replicated database and a web browser as alleged in the Final Rejection at page 5, lines 13-15. Further, Kashino does not remedy this lack of a teaching by ILOG by stating at the cited location of col. 8 line 48 to col. 9 line 28 "While the PDF file may be distributed through a physical medium such as floppy disc, etc., it is common at present to distribute it on the on-line basis by using communication line." This not a teaching of a web browser or the internet or of a distributed, replicated, networked database as alleged in the Office Action and as recited in Claims 2 and 3.

4. Cited prior art does not teach ad box templates comprising entries and ad master templates comprising components, at least one of which components is an ad box. Examiner has cited no part of any reference as supporting such a teaching of what ad box or ad master templates comprise as recited by Claims 5 and 21.

5. Cited prior art does not teach associating rules and roles with said ad box entries and said ad master components nor has the Examiner cited any part of any reference as supporting such a teaching as recited by Claims 6, 10, 22 and 23 but the Examiner only alleges that Johnson's teaching "the layout of a presentation item which implies that templates being controlled by associated business rules and being defined by at least one of company advertiser and ad publisher." Johnson nowhere teaches business rules and roles associated with template entries and components or template definition by an advertiser or publisher. In fact, Johnson is a presentation system to support a sales organization and does not teach supporting an advertiser or publisher. The cited prior art is not even analogous to the

claimed invention's ad box and ad master templates which support a company advertiser in the preparation of ads for submission to a publisher for publishing. Johnson's presentation is not equivalent to or even analogous to the present invention's ad.

6. Examiner cannot use Applicants' invention as a roadmap for combining prior art references against Applicants. The court in *In Re Sang SU Lee*, 277 F.3d 1338, (Jan. 18, 2003) held this is impermissible hindsight and that cited references must contain a specific motivation to combine cited references and there is none here.

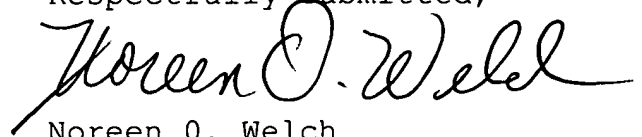
Therefore, the lack of a teaching of a database in which rules, roles and ads are stored in any prior art reference and the lack of a teaching of any means for specifying roles, supports the Applicants' conclusion that the Examiner has failed to make out a *prima facie* case of obviousness (*Ex parte Levengood*, 28 USPQ 2nd 1300 (BPA 1993)). The total lack of a suggestion to combine the references in the manner of the invention to achieve the structure and functions of the invention is impermissible hindsight and this further supports the conclusion that the Examiner has failed to make out a *prima facie* case of obviousness. Finally, that total lack of a teaching of a networked, distributed, replicated database supports the conclusion that the Examiner's combination of references does not teach the claimed invention.

For at least the above reasons, it is respectfully submitted that all ground of rejection stated in the Office Action have been overcome. A Notice of Allowance is respectfully requested.

If any issues remain, which may be best resolved through a telephone communication, the Examiner is requested to kindly

telephone the undersigned at the local, Washington, DC telephone number listed below.

Respectfully submitted,

A handwritten signature in cursive script, reading "Noreen O. Welch". The signature is written in black ink and is positioned above the printed name and registration number.

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